

REMARKS

Applicant amended claims 1, 20, and 35; and added new claims 48-54. New claims 48-54 correspond to original claims 6, 8, 16, 17, 23, 25, and 27, respectively, in independent form. Applicant acknowledges the Examiner's indication that claims 27 is allowable. Claims 1-54 are presented for examination.

The Examiner rejected claims 1-5, 7, 9, 11, 12, 14, 15, 18-20, 21, 24, 26, 28-31, and 33-40 under 35 U.S.C. § 102(b) as anticipated by U.S. Patent No. 5,403,341 (Solar). The independent claims are 1, 20, and 35. As amended, claims 1 and 35 require a sleeve configured to separate into a plurality of detached portions, or separating a sleeve into a plurality of detached portions. Amended claim 20 recites a sleeve having a separation portion extending along a portion of the circumference of the sleeve.

Solar describes a sheath 40 adapted to tear as a stent 10 is radially expanded, but the sheath does not separate into a plurality of detached portions, as recited in amended claims 1 and 35. (See, e.g., Solar Fig. 4c.) With regard to claim 20, Solar shows perforations 42 extending longitudinally along the sheath, not along a portion of the circumference of the sheath. (See, e.g., Solar Fig. 4b.) Therefore, Applicant requests that the rejection over Solar be withdrawn.

The Examiner rejected claims 13 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Solar in view of U.S. 20020052640 (Bigus). Bigus does not cure the deficiency of Solar, as discussed above. Therefore, claims 13 and 22, which depend from claim 1 or claim 20, are patentable for at least the reasons discussed above.

Under 35 U.S.C. § 103(a), the Examiner rejected claims 6, 8, 16, 17, 23, and 25 as being unpatentable over Solar in view of U.S. Patent No. 6,432,129 (DiCaprio); claims 41-47 as being unpatentable over DiCaprio in view of Solar; and claim 46 as being unpatentable over DiCaprio in view of Solar and in further view of U.S. Patent No. 6,315,792 (Armstrong).

DiCaprio could only qualify as a reference under 35 U.S.C. § 102(e). But at the time the claimed invention was made, the subject matter of DiCaprio and the claimed invention were subject to an obligation of assignment to the same entity (Scimed Life Systems, Inc.). Therefore, DiCaprio cannot preclude patentability under 35 U.S.C. § 103. (See, e.g., 35 U.S.C. § 103(c) and

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MPEP 706.02(l)(1).) Applicant requests that the rejections under 35 U.S.C. §103(a) be withdrawn.

New claims 48-53 correspond to original claims 6, 8, 16, 17, 23, and 25, respectively, which were rejected over Solar in view of DiCaprio. But as discussed above, DiCaprio cannot preclude patentability under 35 U.S.C. § 103. Claim 54 corresponds to original claim 27, which the Examiner indicated as allowable. Therefore, the new claims are patentable over the cited references.

Applicants believe the claims are in condition for allowance, which action is requested.